

REMARKS / DISCUSSION OF ISSUES

The present amendment is submitted in response to the Office Action mailed September 28, 2009. In view of the remarks to follow, reconsideration and allowance of this application are respectfully requested.

Status of Claims

Claims 1-14 remain in this application. Claims 1-14 have been amended. The claims in general are amended for one or more non-statutory reasons, for example to correct one or more informalities or obvious errors, remove figure label numbers, remove unnecessary limitations, and /or replace European claim phraseology with U.S. claim language having the same meaning. The claims are not believed to be narrowed in scope and no new matter is added.

Allowable Subject Matter

Applicant wishes to thank the Examiner for indicating that Claims 13 and 14 are allowed.

Drawing Objection

In the Office Action, the drawings were objected to for failing to comply with 37 CFR 1.21(d) because the blocks of Figures 2 and 3 have not been functionally labeled. Applicant respectfully requests withdrawal of the drawings objection and approval of the enclosed proposed drawing changes including a proper labeling of every block in FIGS. 2 and 3.

Specification Objection

In the Office Action, the Specification was objected to for a non-descriptive title. The title has been replaced with a new title. It is believed the new title is clearly indicative of the invention to which the claims are directed. Withdrawal of the objection is respectfully requested.

Claim Rejections under 35 USC 112, second paragraph

In the Office Action, claims 1-12 were rejected under 35 U.S.C. §112, second paragraph. The rejection of claims 1-12 is understood to be based on the premise that the claims are written in a means-plus-function format and, as such, are presumed to invoke a section 112-6 interpretation. The Office asserts that there appears to be no disclosed structure for each of the recited addressing means 31, allocation means 32 and auxiliary data means 32, 34. The “means” appear to correspond to some unspecified configuration of firmware, as recited at page 8, lines 28-32. The Applicants respectfully traverse this rejection.

Title 35 of the United States Code, Section 112, paragraph 6, provides: “an element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in supports thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” Accordingly, a patentee may generically define a structure for performing a particular function through the use of a means expression, provided that the specified structures corresponding to the means are disclosed in the patent specification. Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 28 (1997). In other words, although an applicant may choose “means-plus-function” claim language rather than specifically describing the structures of his invention, the scope of the “means” for performing the stated function must be limited to the structure he specifically disclosed in the specification, and equivalents thereof. The limitation is generally known as the “means-plus-function” or “step-plus-function” limitation.

Applicant’s specification describe a recording device for writing information on a record carrier 11 of a type which is writable or re-writable, as illustrated in Fig 2, and a reading device for retrieving information from a record carrier, as illustrated in Fig. 3, whereby the reading device has elements corresponding to the recording device of Fig. 2. *See* Applicant’s specification, pages 6-11. The structure of the recording device is described in the specification as including a control unit 20 arranged for controlling the recording by locating each block at a physical address in the track. The control unit further includes **an addressing unit 31, an allocation unit 32, a recovery unit 33 and a meta-data unit 34**. Applicant respectfully notes that these units may be implemented in firmware (See

specification @ page 8, lines 31-32), or software, hardware and combinations thereof (See specification @ page 15, lines 8-10). The Office asserts that there appears to be no disclosed structure for each of the addressing means, allocation means and auxiliary data means, as recited in the claims. Applicant respectfully asserts that the recitations at pages 8 and 15 in combination with the figure descriptions provide a sufficient description of structure.

Moreover, the case law holds that is well accepted that when reciting mean-plus-function claims, **no structure is required, where one of ordinary skill in the art would know what the structure was based upon the specification.** In particular, *Card Activation Techs., Inc. v. Barnes & Noble, Inc.*, No. 07 C 1230, Slip Op. (N.D. Ill. Mar. 18, 2008) (Gottschall, J.), where Judge Gottschall denied defendants' motion for summary judgment of invalidity. Each of plaintiff's independent claims – covering a counter-top terminal for processing debit card payments – included a “telecommunications means” limitation. The parties agreed that “telecommunications means” was a means plus function limitation. Defendants argued that the “telecommunications means” was indefinite because **the patent's specification did not recite any corresponding telecommunications structure, such as a modem.** The Court held that the specification did not disclose any specific telecommunications structure. **But the Court held that no structure was required, where one of ordinary skill in the art would know what the structure was based upon the specification,** citing *Aristocrat Tech.*

Australia PTY LTD v. Multimedia Games, Inc., __ F.3d __, 2008 WL 484449 (Fed. Cir. Feb. 22, 2008). Relying upon plaintiff's expert, the Court held that based upon the specification, one of ordinary skill in the art would understand telecommunications means to be a modem.

It is respectfully submitted that the holding in *Card Activation Techs., Inc. v. Barnes & Noble, Inc.*, is applicable in the present matter. More particularly, Applicant submits that one of ordinary skill in the art would understand what structure is necessary to implement the functionality of addressing unit 31, an allocation unit 32, a recovery unit 33 and meta-data unit 34 based on the descriptions provided in the specification and in particular to pages 6-11.

In related support of Applicant's position, MPEP 2181 states that in identifying a 35 U.S.C. 112, sixth paragraph limitation, the proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be **disclosed in the specification itself in a way that one skilled in**

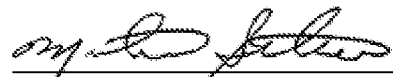
the art will understand what structure (or material or acts) will perform the recited function. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999). It should be understood that whether a claim reciting an element in means- (or step-) plus-function language fails to comply with 35 U.S.C. 112, second paragraph, because the specification does not disclose adequate structure (or material or acts) for performing the recited function is closely related to the question of whether the specification meets the description requirement in 35 U.S.C. 112, first paragraph. See *In re Noll*, 545 F.2d 141, 149, 191 USPQ 721, 727 (CCPA 1976) **(unless the means-plus-function language is itself unclear, a claim limitation written in means-plus- function language meets the definiteness requirement in 35 U.S.C. 112, second paragraph, so long as the specification meets the written description requirement in 35 U.S.C. 112, first paragraph)**. It is respectfully submitted that the Applicant has satisfied this test. Accordingly, withdrawal of the rejections is respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 1-14 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Mike Belk, Esq., Intellectual Property Counsel, Philips Electronics North America, at 914-945-6000.

Respectfully submitted,



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Page 15 of 15

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